

Appl. No. 09/813,636
Amdt. dated October 28, 2005
Reply to Office Action of August 11, 2005

PATENT

REMARKS/ARGUMENTS

Claim Status

Before this Amendment, claims 1-12, and 19-24 were present for examination. Claims 1, 7, and 19 are amended. No claims are canceled or added with this Amendment. Therefore, claims 1-12, and 19-24 are present for examination, and claims 1, 7, and 19 are the independent claims. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

The Office Action of August 11, 2005 ("Office Action") rejected claims 1-12 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,799,286 to Morgan et al. (hereinafter "Morgan"). The Office Action rejected claims 1-6, 22, 7-12, 19-21, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent Publication No. 2001/00132092 to Calver (hereinafter "Calver"). The Office Action has rejected claims 23 and 24 under 35 U.S.C. §102(e) as being anticipated by Morgan.

The Office Action rejected claims 1-6, 22, 7-12, 19-21 under 35 U.S.C. §101 based on the assertion that the claimed invention is directed to non-statutory subject matter. The Office Action rejected claims 1-6, 22, 7-12, 19-21, 23 and 24 under 35 U.S.C. §112, 1st paragraph, as failing to comply with the enablement requirement. The Office Action rejected claims 1-6, 22, 7-12, 19-21, 23 and 24 under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

35 U.S.C. §103(a) Rejection, Morgan, Calver

The Office Action has rejected claims 1-6, 22, 7-12 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Morgan. To establish *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Applicants believe significant limitations from independent claims 1, 7 and 19 are neither taught nor suggested in the references. More specifically, Morgan cannot be relied upon to teach or suggest: (1) a plurality of task or resource entries comprised of future actions, recited in claims 1,

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7, and 19, (2) the mapping recited in claims 1 and 19 or (3) the processing of claim 7. The Applicants respectfully request that the anticipation rejection be withdrawn for these reasons.

1. Task and Resource Entries: Each of independent claims 1, 7, and 19 recite task entries each "comprised of defined types of future action." The Office cites the Morgan "reports for ... trending, forecasting ... [and] benchmarking" to read on the "task entries" of the claims (Office Action, p. 8, ll. 4-7). Morgan, however, describes a "forecasting or budget-generating scenario, [wherein] the automated activity-based management system 10 preferably uses *historical activity information*, in addition to estimated projections for certain *equipment utilization*, *activity cost information*, and *product volume*" (Morgan, col. 7, ll. 56-60).

The "tasks" described in the present embodiments comprise "defined types of *future action*" (emphasis added). These "tasks" constitute various components which may be combined in different ways to accomplish a variety of different activities (Original Application, p. 5, ll. 2-3). The task entries are *generic* components (e.g., research, cold calls, and follow up) of action that can be combined to complete different activities (e.g., sales) in the future (*Id.*, p. 5, ll. 3-4).

But the Morgan forecasting is based on *historical* information and projections for equipment utilization, activity cost information, and product volume - not *tasks* (Morgan, col. 3, l. 66 - col. 4, l. 3). The system in Morgan, for example, looks backward to *specific* employee activities that have *already occurred*, and may make projections based on these past activities (Morgan, p. 8, ll. 32-51; Fig. 10). Morgan, for example, clearly teaches that an *employee or manager* will input backward looking information related to the "time spent." on an activity by people. (Morgan, col. 21, line 32).

The claims similarly recite resource entries each comprised of "defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future." The Office Action again states that Morgan reads on the claims, but Morgan clearly teaches backward looking utilization information related to personnel, facilities and equipment" (Morgan, col. 10, l. 1 - col. 14, l. 39; Figs. 11-14). This information merely attributes *actual, past* personnel, facility and equipment use to certain activities.

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2. Mapping: The mapping in claim 1 and 19 call for future defined tasks to be tied to future resources (personnel and non-personnel) that will be needed to accomplish them. Claim 1 is also amended to recite aspects of the invention more particularly. The Office directs us to the following section of Morgan to read on this mapping: "[the] traditional general ledger view of a computer network operation business unit maps the money spent to salaries, hardware, software, maintenance, and space. The activity-based management view maps these same *expenditures to activities*" (emphasis added Morgan col. 4, lines 1-4).

But as is made clear above, the mapping in claim 1 and 19 are directed at mapping future *tasks* to future *resources*., whereas Morgan maps "**expenditures to activities**" (emphasis added, *Id.*, col. 4, 21-24). The amendment to claim 1 makes this distinction even more clear, specifying that with the mapping, "each task entry is assigned a subset of the plurality of resources." It is evident that the expenditure/activity mapping of the reference fails to teach the task/resource mapping of these claims.

3. Processing Before Any Historical Information Entry: Independent claim 7 recites "processing the resource entry and the task entry with a computer before entry of any historical information for the organization ... [to formulate] a business model." But there is no teaching or suggestion in Morgan which reads on this limitation. The Office, in rejecting this claim, merely refers to its discussion regarding claim 1 (Office Action, p. 10, ll. 12-14). Claim 7 differs from claim 1 in that it specifically sets forth this additional limitation. This limitation is not addressed in the Office Action, and not found in Morgan.

Morgan, instead, describes a "forecasting or budget-generating scenario, [wherein] the automated activity-based management system 10 preferably uses *historical activity information*, in addition to estimated projections for certain *equipment utilization*, activity *cost information*, and *product volume*" (Morgan, col. 7, ll. 56-60). There is simply no suggestion of processing before the entry of this historical information.

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35 U.S.C. §103(a) Rejection, Calver

The Office Action has rejected claims 1-12 and 19-24 under 35 U.S.C. §103(a) as being unpatentable over Calver. The Office, in citing Calver, provides no explanation of the relevance of referenced sections. "The pertinence of each reference, if not apparent, **must be clearly explained**" (emphasis added, 37 CFR 1.104(c)(2)). The lack of *any* guidance from the Office renders it unclear how Calver is relevant, as this reference simply fails to teach the claim limitations. The Applicant requests a Notice of Allowance, or, in the alternative, the required explanation.

35 U.S.C. §101 Rejection

Claims 1-12 and 19-24 were rejected under 35 U.S.C. §101 based on the assertion that the claimed invention was directed to non-statutory subject matter. The independent claims 1, 7, and 19 were amended to address this issue and include a computer. The Office is further directed to Ex Parte Lundgren, BPAI, No. 2003-2088, 9/28/05.

35 U.S.C. §112 1st Rejection

Claims 1-12 and 19-24 were rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. The Applicant respectfully assert that the mapping at issue is clearly supported in the Specification (Original Application, p. 8, ll. 14-30; Figs. 2A & 2B). Reconsideration of this rejection is respectfully requested.

35 U.S.C. §112 2nd Rejection

Claims 1-6, 22, 7-12, 19-21, 23 and 24 are rejected under 35 U.S.C. §112, second paragraph, for failing to particularly point out and distinctly claim the subject matter. The Office appears to assert that there is confusion about use of the term "entry" as it is used in the claims.

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However, the claims are not to be viewed in a vacuum, but in light of the Specification (*See, e.g., Phillips v. AWH Corp.*, Fed. Cir., No. 03-1269, 7/12/05).

Throughout the Specification, the term "entry" is used on numerous occasions, and the use in the claims is abundantly clear. For example, the Specification provides: "*tasks, resources, and systems* for many common business areas are available in templates to pre-populate the various data *entry* screens" (emphasis added, Original Application, p. 7, ll. 11-12). And the interaction between tasks, resources, systems, and entry screens is made clear as well (*Id.*, p. 8, ll. 2-4). Applicants respectfully assert that the claims at issue are clear in light of the Specification, and this rejection is traversed.

Claim 6 addresses the term "organization," and the Office again asserts a lack of clarity. The Applicant respectfully disagrees, as support for the meaning ascribed in claim 6 is found in the Specification, and is clear (*Id.*, p. 3, ll. 4-5). This rejection of claim 6 is respectfully traversed.

Claim 4 is amended to address the issue related to antecedent basis.

35 U.S.C. §1.75 Objection

Claims 2, 8-11, 23, and 24 are objected to under 35 U.S.C. §1.75 (c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. As noted in the previous Amendment dated May 5, 2005, claim 2 depends from claim 1, and further comprises "a step of attributing overhead expenses to the organization as a whole." This clearly is more limiting than claim 1. As the Published Specification points out in [0016], information could be input for the organization *or* individual personnel or systems. Claim 2 requires that certain overhead expenses be attributed to the organization as a whole, which would exclude individual personnel, for example, and thus is more limiting.

Claims 8-11, 23 and 24 are dependent claims which, like claim 2, more particularly point out certain aspects of the claimed embodiments. When a dependent-claim more particularly describes an aspect of an independent claim, other options for performing that

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claim then are foreclosed. For example, in claim 8, the "step of processing an activity entry" is included. In independent claim 7 (from which claim 8 depends), that step may, or may not, be included. Claim 8 is thus more limiting. Similar reasoning applies to the rest of the claims as well.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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